

'473 patent. In deciding whether Dell, Western Digital, and Hitachi have persuaded you of their invalidity defenses, you may consider that you have heard evidence that the Patent and Trademark Office had no opportunity to evaluate before granting the patent.

Authority: *Microsoft Corp. v. i4i Limited Partnership*, 131 S. Ct. 2238 (2011).

2.9 REVISED -- INVALIDITY GENERALLY

Now, with respect to validity, Dell, Western Digital, and Hitachi contend that the asserted claims of Convolv's '473 patent are not valid. Defendants have the burden of proving invalidity by a preponderance of the evidence, except for pure factual issues, which must be proven by clear and convincing evidence. Clear and convincing evidence is a more exacting standard than proof by a preponderance of the evidence, which only requires that a party's claim be more likely than not true. Nevertheless, the clear and convincing standard is not as high as the burden of proof applied in a criminal case, which is beyond a reasonable doubt. In deciding whether Defendants have met this burden, you may consider that the United States Patent Office never considered or evaluated some of the prior art in this case and that the United States Patent Office may have reached a different conclusion if it had considered or evaluated the prior art in this case. If the United States Patent Office did not have all material facts before it, the burden to persuade you of the factual basis for the invalidity defense by clear and convincing evidence may be easier to sustain.

Defendants contend the asserted claims are invalid because the asserted claims were anticipated or obvious in view of the prior art. You should analyze each claim separately. If you find by clear and convincing evidence that a claim is anticipated or obvious, then you should find that claim invalid and render a verdict for Defendants on that claim.

Authority: *Microsoft Corp. v. i4i Limited Partnership*, 131 S. Ct. 2238 (2011).

2.10 ADDITIONAL INSTRUCTION – PRIOR ART

Prior art includes publications and products that are not described in United States patents.

Authority: 35 U.S.C. § 102.

2.13 ADDITIONAL INSTRUCTION – ON SALE BAR

Additional language is added below in bold and italics.

The sale or offer for sale in the United States of a product is prior art to a patent claim covering the product or a method of making the product if the product was sold or offered for sale in the United States more than one year before the application for the patent was filed. In this case, the '473 patent was filed on March 4, 1999. So ***the prior art date in this case*** is March 4, 1998. The date of invention for the patent claims is irrelevant to this category of prior art. If the sale or offer for sale of a product is more than one year before the patent application was filed, then the product or method of making it is prior art, regardless of the date of the invention. ***The product on sale does not need to specifically inform customers of the functionality covered by it.***

Authority: 35 U.S.C. § 102.

2.17 ADDITIONAL INSTRUCTION – DAMAGES GENERALLY

Claims 7 and 10 are method claims and are only infringed when the steps of the method are actually performed, not if the steps of the method claim merely can be performed. Thus, for claims 7 and 10, you can only award damages for each instance when the steps of these claims were actually performed.

Authority: *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 576 F.3d 1348, 1358 (Fed. Cir. 2009) (“The district court was also correct in limiting damages to sales of ICDs that performed the steps of the claimed method.”).

2.18 ADDITIONAL INSTRUCTION – DAMAGES DATES

Actual notice requires the affirmative and direct communication from Plaintiff to Defendant of a specific charge of infringement by a specific accused product or device. Plaintiff's communications to a standard setting organization of which Defendants were members does not constitute notice. Further, communications from other parties to Defendants concerning the patent do not constitute notice.

Further, Plaintiff may contact Defendants if Plaintiff believes that Defendants might be infringing Plaintiff's patent. Plaintiff is not required to be certain that Defendants are infringing to contact them.

Authority: *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994); *Devices for Medicine, Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987) ("Absent notice, [the alleged infringer's] 'knowledge of the patents' is irrelevant."); *AT & T Corp. v. Microsoft Corp.*, 290 F. Supp. 2d 409, 414 (S.D.N.Y. 2003).

2.20 ADDITIONAL INSTRUCTION – WILLFUL INFRINGEMENT

Additional language is added below in bold and italics.

To prove that a Defendant acted recklessly, Convolve must prove two things by clear and convincing evidence. The first part of the test is objective: Convolve must persuade you that the Defendant acted despite a high likelihood that the Defendant's actions infringed a valid and enforceable patent. In making this determination, you may not consider the Defendant's state of mind. Legitimate or credible defenses to infringement, even if not ultimately successful, demonstrate a lack of recklessness. ***To willfully infringe a patent, the patent must exist and one must have knowledge of it.*** Only if you conclude that a Defendant's conduct was reckless do you need to consider the second part of the test.

Authority For Additional Instruction: *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985); *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1562-63 (Fed. Cir. 1994); *Sundance, Inc. v. Demonte Fabricating, Ltd.*, No. 02-73543, 2007 WL 2287829, at *9 (E.D. Mich. Aug. 1, 2007).

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was filed electronically on July 24, 2011, pursuant to Local Rule CV-5(a) and has been served on all counsel who are deemed to have consented to electronic service.

/s/ Deron R. Dacus
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